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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,034	09/23/2003	Ellis A. Pinder	CM06386J	1818

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MOTOROLA, INC
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EXAMINER

SANTIAGO CORDERO, MARIVELISSE

ART UNIT PAPER NUMBER

2617

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/669,034

Applicant(s)

PINDER, ELLIS A.

Examiner

Marivelisse Santiago-Cordero

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER

Continuation Sheet

1. Applicant's arguments filed on 5/29/06 have been fully considered but they are not persuasive.
2. Regarding claim 1, Applicant argues that nothing in the sections cited by the Examiner teach or suggests the installation aspect as claimed (see Remarks: Rejection – 35 U.S.C 102(e)). The Examiner respectfully disagrees. The cited portions of Curtiss et al., i.e., paragraphs [0014], [0050], and [0042] clearly teaches or suggests installable accessory options. Note that the register of Curtiss is any type of storage unit configured to store data that defines or controls certain aspects of operation (Curtiss: page 5, paragraph [0050]). Moreover, paragraph [0014] discloses that, in order to overcome prior art drawbacks, the accessory includes memory configured to store data for the advantage of the most current data, which is tailored for the accessory, and if the accessory must be modified, the data may also be updated to provide flexibility for future use of different components in the accessory, hence installable accessory options as stated in the claim. Paragraph [0042] further cites that storing control data on the accessory provides the advantages of reducing the storage requirement on the communication device insuring updated and tailored control data for use with the accessory, providing flexibility for future use of different components in the accessory which may necessitate the use of modified control data; hence, installable accessory options as claimed.
3. Applicant argues that Curtiss teaches away from installation of accessory options in paragraph [0014] (see Remarks: Rejection – 35 U.S.C 102(e)). The question whether a reference ‘teaches away’ from the invention is inapplicable to an anticipation analysis. See MPEP § 2131.05.

Moreover, in the cited paragraph, Curtiss discloses that new accessories with the most up to date control data may be released, and if the accessory must be modified, the control data may also be updated.

4. In response to applicant's arguments that the register of Curtiss is not an installable option, but rather a physical presence (see Remarks: 5th full paragraph); the Examiner contends that the register includes the installable options; hence, what meets the claim language is the content of the register alone or in combination with the register itself.

5. Regarding claim 5, Applicant argues that Curtiss fails to teach installable modules and actually teaches away from this aspect (Remarks: 6th paragraph). The response stated above also applies to these arguments and again, the question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis. See MPEP § 2131.05.

In addition, Applicant argues that even if control data were to be updated there is no teaching or suggestion in Curtiss as to how the updates are accomplished (Remarks: 6th paragraph). In response, it is noted that the features upon which applicant relies (i.e., how the updates are accomplished) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Regarding claim 13, Applicant argues that Curtiss teaches away from updating locally (see Remarks: 7th paragraph). In response, the question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis. See MPEP § 2131.05.

Applicant's contends that Curtiss utilizes the electronic device side in all updates (see Remarks; 3rd page). In response, the Examiner respectfully disagrees. 1) Applicant has

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recognized another advantage which would flow naturally from following the suggestion of the prior art (a portion of Curtiss not relied upon by the Examiner). 2) The teaching applied from Curtiss clearly shows the accessory perform the comparison instead of the electronic device (see paragraph [0056]).

7. Regarding dependent claims 18-22 and 24-26, Applicant argues that the accessory options of Applicant's invention are not being installed into the phone – the accessory options of Applicant's invention are being installed into the accessory (See Remarks). In response, it is noted that, as stated in the last Office Action, Curtiss discloses that in the prior art the data was stored in the phone at the time the phone leaves the manufacturing plant, i.e., factor-installed, or when the phone is sold, the latter being interpreted as user-installed and that it is inherent feature from Curtiss disclosure that this can be done for the at least one accessory option or installable modules. The Examiner also cited paragraph [0067] of Curtiss where it discloses that data may be written to the accessory.

8. Regarding claims 7, 9-12, and 23, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

9. In addition, regarding claim 10, Applicant argues that neither reference taken individually or in combination teaches or suggests installing an optional configuration into the accessory (see Remarks: Rejection – 35 U.S.C 103 (a); 3rd paragraph). The responses stated above also apply to this argument.

10. Regarding claim 12, Applicant argues that the cited references taken individually or in combination do not teach the sequence of steps that configure the accessory prior to detection

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and operation with the radio (see Remarks: Rejection – 35 U.S.C 103 (a); 4th paragraph). In response, the claim does not exclude radio from the beginning as argued.

In addition, it is noted that the features upon which applicant relies (i.e., the steps of powering, reading, comparing, and configuring *all happening at the accessory side*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).